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In re Application of	:	DECISION ON
MATSUI	:	
Application No.: 10/561,629	:	PETITION UNDER
PCT No.: PCT/JP2004/008710	:	
Int. Filing Date: 21 June 2004	:	37 CFR § 1.47(b)
Priority Date: 20 June 2003	:	
Attorney Docket No.: 19036/40796	:	
For: OPTHALMIC COMPOSITION	:	

This is a decision on applicant's third renewed petition under 37 CFR 1.47(b) filed in the United States Patent and Trademark Office (USPTO) on 23 October 2008.

**BACKGROUND**

On 21 June 2004, applicant filed international application PCT/JP2004/008710, which designated the US and claimed a priority date of 20 June 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 29 December 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 20 December 2005.

On 20 December 2005, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 06 July 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventor in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) were required. The NOTIFICATION set a two-month extendable period for reply.

On 07 February 2007, applicant submitted a petition under 37 CFR 1.47(b) and a petition under 37 CFR 1.183. The petitions were accompanied by, *inter alia*, a petition/fee for a five month extension of time, the surcharge under 37 CFR 1.492(h), a declaration of facts by Madoka Yamashita, and a memorandum of law by Tadato Fujiwara.

On 16 March 2007, applicant submitted a petition under 37 CFR 1.182.

On 11 June 2007, a decision was mailed dismissing without prejudice applicant's petition under 37 CFR 1.47(b), applicant's petition under 37 CFR 1.183, and applicant's petition under 37 CFR 1.182.

On 09 October 2007, applicant filed a renewed petition under 37 CFR 1.47(b) and the petition under 37 CFR 1.59(b). The petition under 37 CFR 1.47(b) was accompanied by, *inter alia*, a declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, a statement of facts by Naoka Harada, a statement of facts by Yasuyo Yamaguchi, a statement of facts by Naonori Murakami, an English translation of the priority document for the instant application—Japanese Application No. 2003-176965, a chart showing support in the English translation of the priority document for the claims in the instant application, a copy of an oath signed by nonsigning inventor Yuka Matsui dated 16 April 2001 and an English translation thereof, and a copy of "Regulations for Employee's Invention" and an English translation thereof.

On 24 March 2008, a decision was mailed dismissing without prejudice applicant's petition under 37 CFR 1.47(b) and granting applicant's petition under 37 CFR 1.59(b). Regarding the petition under 37 CFR 1.47(b), it was noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had not been provided.

On 20 May 2008, applicant filed a second renewed petition under 37 CFR 1.47(b) which was accompanied by a "redline" comparison of the specification portion of the English translation of the priority application and the specification portion of the international application

On 01 October 2008, a decision was mailed dismissing without prejudice applicant's petition under 37 CFR 1.47(b). Specifically, it was noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had not been provided.

On 23 October 2008, applicant filed the instant renewed petition under 37 CFR 1.47(b).

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

As noted in the decision mailed 01 October 2008, items (1)-(4) and (6) have been met.

Item (5) has now been met as well. Applicant's remarks filed 23 October 2008 satisfactorily explain that the differences between the priority application and the international application are not significant.

### **CONCLUSION**

For the above reasons, applicants' renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **09 October 2007**.

/Daniel Stemmer/

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In re Application of  
MATSUI  
Application No.: 10/561,629  
PCT No.: PCT/JP2004/008710  
Int. Filing Date: 21 June 2004  
Priority Date: 20 June 2003  
Attorney Docket No.: 19036/40796  
For: OPTHALMIC COMPOSITION

Dear Ms. Matsui:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/Daniel Stemmer/

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